

the Examiner, in particular claims that are in the same class, as are the claims of Groups II and III. Applicant therefore requests that the Restriction Requirement be withdrawn with respect to Groups I-III and that all claims be examined together.

### REMARKS

*A. An Examiner may not reject a particular claim on the basis that it represents "independent and distinct" inventions*

By restricting a single claim and placing it in more than one group, the Examiner is alleging that the single claim represents multiple "patentably distinct" inventions. As such, this type of restriction requirement is a *de facto* rejection of the patentability of the claim, because the claim cannot issue as drafted. As the C.C.P.A. noted:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *In re Weber, Soder and Boksay*, 198 USPQ 328, 331 (C.C.P.A. 1978). *See also In re Haas*, 179 USPQ 623, 624-625 (C.C.P.A. 1973) (*In re Haas I*); and *In re Haas*, 198 USPQ 334, 334-337 (C.C.P.A. 1978) (*In re Haas II*). *See also* MPEP § 803.02.

Moreover, it has long been held that an Examiner may not reject a particular claim on the basis that it represents "independent and distinct" inventions. *See In re Weber*, 198 USPQ at 328. The courts have definitively ruled that the statute authorizing restriction practice, i.e., 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement

on a single claim, even if the claim presents multiple independently patentable inventions. *See id.*; *In re Haas I*, 179 USPQ at 623; and *In re Haas II*, 198 USPQ at 334. In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In re Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-no matter how broad, which means no matter how many independently patentable inventions may fall within it. *In re Weber*, 198 USPQ at 334.

Therefore, rejecting claims 1, 4, and 5 for misjoinder and on the basis that they allegedly represent independent and distinct inventions is clearly improper. Applicant thus respectfully request that the Examiner withdraw the improper restriction requirement with respect to Groups I and II.

*B. Examining the claims of Groups II and III together does not place an undue examination burden on the Examiner*

Furthermore, restriction of an application is discretionary. A restriction requirement is made to avoid placing an undue examination burden on the Examiner and the Office. Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits, even though they are directed to independent and distinct inventions. MPEP § 803.01. Applicant respectfully submits that examining the claims of Groups II and III together would not place an undue burden on the Examiner.

In establishing that an “undue burden” would exist for co-examination of claims, the Examiner *must* show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show one of the following, as set forth in MPEP § 808.02:

(1) *Separate classification thereof:*

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(2) *A separate status in the art when they are classifiable together:*

Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(3) *A different field of search:*

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

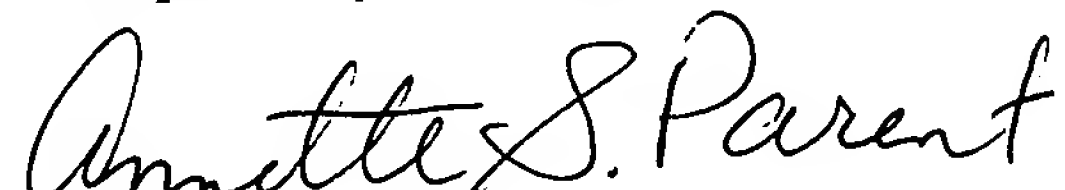
The claims of Group II relate to methods of assaying for compounds that modulate a G-protein alpha subunit in cells expressing the subunit, by examining the functional effect of the compound on the subunit. The claims of Group III relate to methods of assaying for compounds that modulate a G-protein alpha subunit in HEK 293 cells expressing the subunit, by examining changes in intracellular calcium levels. However, both of these groups claim methods of modulating the same G-protein alpha subunit, expressed in a cell, by examining a functional effect. The only distinction between Group II and Group III is that Group III is a subgenus of Group II, as Group III specifies the cell type in which the G-protein alpha subunit is expressed (HEK 293 cells) and the functional effect used to determine modulation (detecting changes in intracellular calcium). Furthermore, as such method claims are traditionally searched in the art by the amino acid sequence of the protein being modulated, Applicant submit that searching Groups II and III together places no undue examination burden on the Examiner. Applicant therefore respectfully request that the restriction

requirement with respect to Groups I, II, and III be withdrawn and that all the claims be searched and examined together.

**CONCLUSION**

If the Examiner has any questions regarding Applicant's election, or if the Examiner believes that a telephone conference would expedite consideration of this matter in any way, please call the undersigned at 415-576-0200.

Respectfully submitted,

  
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